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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,827	02/25/2004	Joe E. Maskasky	87073JLT	5059

7590 06/14/2005

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EXAMINER
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CHEA, THORL

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/786,827	MASKASKY ET AL.	
	Examiner	Art Unit	
	Thorl Chea	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>02252004</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is no antecedent basis for "color developing agent precursor". Claim 15 is related to a protective layer.

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-15, 18, 19, 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slusarek et al (US Patent No. 6,426,179).

Slusarek et al discloses a photothermographic material substantially as claimed. See Type 1: thermal process systems (thermographic and photothermographic) where processing is initiated solely by application of heat to the imaging element; non-photosensitive source of reducible silver ion including silver behenate in column 37, lines 64-68 to column 38; the blocked photographically useful group of structure in column 3, formula (I) and columns 11-24; the blocked compound that decomposes by a 1,4 or 1,6 elimination mechanism to release a photographically useful group on thermal activation

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to from developed image at temperate between 100 °C to 160 °C; the color coupler magenta and cyan image forming coupler in column 31, lines 4-6; binder including gelatin and latex in column 40, lines 34-61; the toning agent including phthalazine and phthalazinone in column 40, lines 12-23; the use of the blocked developer in thermographic element and the thermographic imaging mean such as laser in column 41, lines 66-67 to column 42, lines 1-10. in column 33, lines 36-42, it is disclosed that "the imaging element of the present claimed invention may also be black and white image-forming material comprised, for example, of a pan-sensitized silver halide emulsion and developer of the invention. In this embodiment, the image may be formed by developed silver density by processing, or by a coupler that generate a dye which can be used to carry the neutral image scale. Slusarek et al may not exemplify the use of a cyan dye forming and a magenta dye-forming coupler to produce form a black and white image claimed, but discloses the claimed blocked developer, the cyan color forming coupler and magenta dye forming coupler including the use of a coupler to generate a dye which can be used to carry a neutral image scale (black and white). Therefore, it would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use a color couplers such as cyan dye forming coupler, magenta dye forming coupler in combination with the blocked developer to form neutral image scale such as suggested by Slusarek et al, and thereby provide an invention as claimed.

3. Claim 15, 16, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slusarek et al as applied to claims 1-15, 18, 19, 21-23 above, and further in view of Murray (US Patent 5,705,324). The teachings of Slusarek et al is as shown in the paragraph above. Slusarek et al may not discloses a protective layer presented in claim

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15, 16 and the process of claim 18. Murray discloses a protective topcoat layer for a thermographic element in column 4, lines 25-36 and the process having steps as claimed in column 4, lines 41-61, and claims 20-23. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to form a topcoat layer to protect the image forming layer of a thermographic material taught Slusarek. Also, it would have been obvious to use the developed thermographic material taught in Slusarek et al as a mask in the process taught in Murray to provide a process as claimed.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-23 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of copending Application No. 10/786,852 in view of Cerquone et al (US Patent No. 4,021,240). The invention as claimed and the invention claimed in the copending Application No. 10/786,852 differs in the use of the reducing agent for the reducible silver ions. Cerquone discloses a use of color developer and a reducing agent in combination in a thermographic material to produce a desired dye in the imagewise exposed area. See

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column 6, lines 30-60. It would have been obvious to use the reducing agent for silver ion in the claimed material to produced a desired dye, and thereby provide a material as claimed in the copending application.

This is a provisional obviousness-type double patenting rejection.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references provided with the information statement disclosure statement on May 25, 2004 have been considered and made of record.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571) 272-1328. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Tch *th*  
June 8, 2005

*Thori Chea*  
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Primary Examiner  
Art Unit 1752